

REMARKS

CLAIM REJECTION – 35 USC § 103

I. Chauchard does not teach a Facilitator's web site for facilitating the filing of a trademark

The OA on page 3 states:

Examiner agrees that Chauchard teaches the use of a local computer to facilitate filing a trademark.

Applicant respectfully traverses the 35 USC § 103 rejections because the OA fails to establish prima facie obviousness, which requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03; In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Applicant submits that not all the claimed limitations are either taught or suggested by the cited prior art. Specifically, the Examiner admits that Chauchard teaches using a local computer and not the claimed Facilitator's web site for facilitating the filing of a trademark. Since at least this limitation is not taught or suggested by the prior art, Applicant respectfully requests the withdrawal of this rejection.

The OA on page 3 continues with:

However, Chauchard was originally filed in 2000. It is a natural progression, with the wide-spread use of the internet and web sites which facilitate many services, that rather than using a program to file for a trademark, a web site may be used. Further, Go Daddy provides a web site which provides the service of registering domain names; it would have been obvious to combine Go Daddy's registration service with other, related services, such as registering those same domain names as trademark.

Applicant respectfully submits that, in addition to improperly adding teachings to the prior art that are not there, the Examiner is using impermissible hindsight in determining obviousness. In determining obviousness, MPEP 2141.03 states in part "[t]he person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention." The Examiner never mentions Applicant's filing date of March 29, 2004 (the latest possible date of invention) as the appropriate time to determine obviousness and appears instead to be determining obviousness by today's technological standards. Specifically, when the Examiner states in the OA on page 3 that "it is a natural progression, with the wide-spread use of the internet and web sites which facilitate many services, that rather than using a

program to file for a trademark, a web site may be used” (underlining added) the Examiner appears to be judging obviousness by today’s standards (particularly since the Applicant’s filing date is never mentioned) and is thus using impermissible hindsight.

In summation, a Facilitator’s web site for facilitating the filing of a trademark as recited in claims 1, 7, 13 and 19 is not shown in the prior art as admitted by the Examiner. Further, it is improper to add a teaching to the prior art merely by saying it would have been obvious. All limitations must be taught or suggested by the prior art and a Facilitator’s web site for facilitating the filing of a trademark is not taught or suggested. The Examiner’s obviousness analysis is further corrupted by the Examiner not using the proper time-frame in determining obviousness. Thus, Applicant respectfully requests the withdrawal of this rejection.

II. No teaching, suggestion or motivation to combine provided, except from Applicant’s own disclosure.

MPEP 2142.01 I. states:

Obviousness can * be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. In re Kahn, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching *test< as a guard against using hindsight in an obviousness analysis).

The Examiner has concluded, with no cite or support from the prior art, that it would have been obvious to combine Go Daddy and Chauchard “with reasonable expectation of success.” The Examiner has not shown any teachings, suggestions or motivations in the prior art to combine Go Daddy and Chauchard to form the present invention. The motivation appears to come from the present invention’s specification. It is improper to use knowledge gained from the present invention to form a motivation to combine which exists nowhere in the prior art. Because there is no teaching or suggestion in the prior art to combine the prior art as proposed by the Examiner, Applicant respectfully requests the withdrawal of this rejection.

CLAIM REJECTION – 35 USC § 112

Claims 1, 7, 13 and 19 have been amended by replacing “accepting” with “allowing access to.” Applicant respectfully submits that this fully responds to the Examiner’s rejection and requests the withdrawal of the 35 USC § 112 rejection.

CONCLUSION

Applicant respectfully submits that Go Daddy and Chauchard do not teach all the claim limitations as explained above. Applicant thus requests the allowance of all pending claims, i.e. claims 1-19, as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorneys for Applicants at the telephone number or email address listed below.

Respectfully submitted,

The Go Daddy Group, Inc.

Date: 8/29/2009

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